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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,363	11/16/2001	Kenneth G. De Souza	9794.00	5597

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,363

Applicant(s)

DE SOUZA ET AL.

Examiner

James S McClellan

Art Unit

3627

llw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on March 8, 2004, wherein:
 - claims 1-31 are pending;
 - claims 1, 6, 14, and 19 have been amended; and
 - claims 27-31 have been added.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 9-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to the social sciences) and therefore are found to be non-statutory subject matter. For a process, the recited process must somehow apply, involve, use, or advance the technological arts.

Art Unit: 3627

In the present case, claims 9-10 fail to apply, involve, use, or advance the technological arts. It is noted that method claims 1-8 and 11-13 all include a transponder which the feature that uses the technological arts. The method of claims 9-10 can be carried out manually.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 9, 10, 22, 23, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. US 2003/0078864 A1 (hereinafter “Hardesty”).

Regarding **claim 9**, Hardesty discloses a method, comprising maintaining a score of bonus points for a customer (see paragraph 0007); detecting entry of the customer through a portal (consumers “visit” certain websites via a portal); and in response to the entry, increasing the score (see paragraph 0007); [**claim 10**] the step of detecting entry is accomplished with no social interaction with the customer (inherent because account identification is electronic); and [**claim 28**] wherein increasing the score is done without detecting a purchase by the customer (paragraph 0007 offers incentives for merely visiting/entering web sites).

Regarding **claim 22**, Hardesty discloses a system as set forth in claim 9. **Claim 23** is similar to claim 10 and is rejected for the same reasons as described above in detail.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 11, 13-21, 24, 26, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,513,015 (hereinafter "Ogasawara").

Regarding **claim 1**, Ogasawara discloses a method, comprising at a portal to enclosure, receiving an identity signal from a transponder (see paragraph bridging columns 8-9); locating an account, based on the identity signal (see column 8, lines 4-16); creating a change in the account (see column 13, lines 38-55); **[claim 2]** the transponder is carried by a person (see Figure 1); **[claim 3]** the change in the account is beneficial to the person (see column 13, lines 38-55); **[claim 4]** the identity signal is invisible to third parties (inherent); and **[claim 5]** no social interaction with the person accompanies locating the account (inherent because account identification is electronic).

Regarding **claim 6**, Ogasawara discloses a method, comprising at a portal to an enclosure, receiving an identity signal from a transponder carried by a person (see paragraph bridging columns 8-9); and issuing an award to a party identified by the identity signal (see column 13, lines 38-55); **[claim 7]** the party identified is identical to the person (inherent); and **[claim 8]** the award is accompanied by no social interaction with the person at the time the identity signal is received from the transponder (inherent because account identification is electronic).

Regarding **claim 14**, Ogasawara discloses a system as set forth in claim 1. **Claims 15-18** are similar to claims 2-5 and are rejected for the same reasons as described above in detail.

Regarding **claim 19**, Ogasawara discloses a system as set forth in claim 6. **Claims 20-21** are similar to claims 7-8 and are rejected for the same reasons as described above in detail.

Regarding **claims 1, 6, 14, 19, and 31**, Ogasawara fails to explicitly disclose creating a change in the account prior to any purchase by a party identified by the identity signal.

Hardesty teaches the use of creating a change in the account prior to any purchase by a party identified by the identity signal (paragraph 0007 notes that incentives are granted to users for merely *visiting* a website as compared to purchasing a product or service).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ogasawara with awarding incentives for merely entering the store as taught by Hardesty, because providing an incentive for a customer to merely “visit” or enter the store attracts customers to the store, wherein inherently increasing the likelihood that the person will make a purchase.

Regarding **claims 11 and 13**, Ogasawara fails to explicitly disclose transmitting a message to a location in response to the identify signal.

Hardesty teaches awarding an incentive in response to the identify signal of a user, when the user merely “visits” the retail store (in this case electronically, see paragraph 0007) and further teaches sending a message to the person and a third party which results in modification of a monetary account of the person (see paragraph 0046).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ogasawara with a response to the identify signal as taught by Hardesty,

Art Unit: 3627

because providing an incentive for a customer to merely “visit” or enter the store attracts customers to the store, wherein inherently increasing the likelihood that the person will make a purchase.

Regarding **claim 24**, Ogasawara and Hardesty disclose a system as set forth in claim 11.

Claim 26 is similar to claim 13 and is rejected for the same reasons as described above in detail.

8. Claims 12, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara in view of Hardesty as applied to claims 1-8, 11, 13-21, 24, 26, and 29-31 above, and further in view of U.S. Patent No. 5,903,880 (hereinafter “Biffar”).

Regarding **claim 12**, Ogasawara in combination with Hardesty et al. show all the claimed elements as set forth above except for the use of the message comprises an e-mail message addressed to the person.

Biffar teaches the use of e-mailing incentive/loyal award information (see column 16, lines 49-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ogasawara with e-mail notification of loyalty information, because e-mailing account information will allow users to keep track of potential awards or incentives.

Regarding **claim 25**, Ogasawara, Hardesty et al., and Biffar disclose a system as set forth in claim 12.

Regarding **claim 27**, Ogasawara discloses using a non-contact detector to detect entry (as set forth above in detail).

Response to Arguments

9. Applicant's arguments filed March 8, 2004 have been fully considered but they are not persuasive.

On page 5-12, Applicant argues the 35 U.S.C. § 102 rejection based on Ogasawara. Applicant's arguments are moot because a new ground of rejection was necessitated by Applicant's amendment.

On page 12, final paragraph (continued on page 13), Applicant argues that Hardesty indicates that users will receive an incentive in advance of visiting a website. The Examiner respectfully disagrees with Applicant's interpretation of the reference. What advantage is there for the website of Hardesty to give incentives to the user without visiting? The keyword in paragraph 0007 is "visit". Unlike traditional loyalty programs that required a purchase, Hardesty optionally discloses rewarding the user for merely visiting the website.

On page 13, under Problem 2 (see also page 14, first full paragraph), Applicant argues that Hardesty does not disclose "detecting entry of the customer through a portal". The Examiner respectfully disagrees. As set forth above, it is the Examiner's position that a user must visit a website to receive the loyalty reward from the website. Loyalty programs users must utilize a service to thereby be loyal. Therefore, a loyalty award would only be given to a user on the Internet when they were loyal, in this case, when the user visits the website. How does a website know when a customer is being loyal? The website must detect the presence of the user entering or visiting the site. Therefore, the Examiner concludes that Hardesty's disclosed loyalty program detects the presence of a user entering the site.

Additionally, Applicant argues on page 13 (also page 17, first paragraph), that claims are not read metaphorically. Applicant is relying on a narrow reading of the word “enter” to merely mean the physical entry of a person into a physical location. However, *Merriam Webster's Collegiate Dictionary*, tenth edition defines “enter” more broadly, “to go or come in”. The Examiner is permitted to read claim language as broadly as reasonably possible using an ordinary dictionary definition. In this case Applicant is correct in stating that the term “enter” is commonly used in connection with accessing information electronically and that is the use of the term “enter” that the Examiner is relying upon. Additionally, the Examiner notes that Applicant failed to provide an authority for his argument that claims are not read metaphorically.

On page 14, second full paragraph, Applicant cites MPEP 2173.05(a). The Examiner acknowledges Applicant's citation and asserts that the Examiner's interpretation is consistent with the specification.

On page 14, final paragraph, Applicant argues that Applicant's specification has no support for identifying a visitor to a website and therefor the Examiner's reliance on Hardesty does not anticipate the claim language. The Examiner respectfully disagrees. The Examiner's rejection using Hardesty meets all the claim limitations and therefore anticipates the claim.

On page 15, second paragraph, Applicant argues that the claim language is “portal to an enclosure”, which Applicant alleges is not shown in the reference. Applicant's argument is unclear. What claim? What reference? All claims related to a “portal to an enclosure” are disclosed by Ogasawara (see column 8, lines 55-58).

On page 15, under Additional Point 3, Applicant argues that various meanings for claim terms exist, and the meaning which corresponds to the specification must be used. The

Art Unit: 3627

Examiner respectfully disagrees. “Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO’s definition unreasonable when the PTO can point to other sources that support its interpretation.” *In re Morris*, 127, F3.d at 1056, 44 USPQ2d at 1029. In this case, Applicant has not expressly defined each term in the specification.

On page 15, under Point 1, Applicant argues that Hardesty should be subject to the same objection, yet Hardesty has been issued. First, 35 U.S.C. § 101 is a rejection, not an objection. Second, Hardesty is a published patent application, not a issued patent. As a published patent application, Hardesty’s claims have not been examined. Third, even if the Hardesty was patent and it was issued improperly, that does not prevent the Examiner in this case from following proper guidelines for examination.

On page 15, final paragraph, Applicant states that counting and detecting as required in claim 9 is the most basic “technological arts”. The Examiner respectfully disagrees. Claim 9 does not apply, involve, use, or advance the technological arts. The limitations in claim 9 can be carried out as mental steps in someone’s brain. For a claim to be statutory, it must be in the technological arts. *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974).

On page 16, under Point 1, Applicant argues that Hardesty does not include a transponder. Ogasawara, not Hardesty, is relied upon to disclose a transponder.

On page 17 (continued on page 18), Applicant argues that when you visit a website, the website does not know your identity. In this case, Hardesty must know the identity of the user to grant loyalty awards.

Art Unit: 3627

On page 4, under Point 4, Applicant argues that Hardesty's actions are not in response to anything. The Examiner respectfully disagrees. Hardesty's actions are in response to a loyal customer visiting a website.

On page 19, under Problem 1, Applicant argues that claim 11 is not part of the prior art, and cannot be used in the rationale. The Examiner did not rely on claim 11 when forming the rejection. The Examiner relied upon the teachings from Ogasawara and Hardesty and motivation from one of ordinary skill in the art at the time the invention was made.

On page 19 under Problem 2, Applicant argues that the presence of common elements in both the claims and a reference is not a basis for combining the reference with another reference. Once again, the Examiner relied solely on the references and motivation from one of ordinary skill in the art at the time the invention was made.

On page 20, first full paragraph, Applicant argues that claim 11 (a) and (b) are not found in Hardesty. As set forth above in the detailed analysis of each prior art rejection, the Examiner relied upon the combination of Ogasawara and Hardesty to disclose all limitations of claim 11.

On page 20, under Problem 4, Applicant argues that there is no motivation to combine the references. The Examiner respectfully disagrees. As Applicant correctly notes, there are numerous different incentives for attracting customers to a store. In this case, providing loyalty points upon merely visiting the store, as taught by Hardesty, will be beneficial to Ogasawara by providing greater incentive for customers to purchase items.

On page 21, fourth full paragraph, Applicant argues that no valid teaching has been given for combining the Ogasawara, Hardesty, and Biffar. The Examiner respectfully disagrees.

Art Unit: 3627

Keeping track of awards and incentives is a desirable feature for customers. Since customers find that feature desirable, it would be obvious for Ogasawara to implement the feature.

On page 22, Applicant argues that the rejection of claims 12 and 25 does not show that he dependent claim as a whole is obvious. The Examiner respectfully disagrees. The Examiner set forth citations for each limitation in the claim and provided motivation for making the combination as a whole.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

Art Unit: 3627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

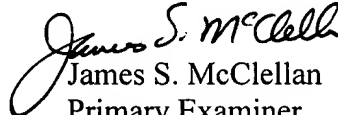
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Commissioner of Patent and Trademarks
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or faxed to:

(703) 872-9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
April 30, 2004